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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,875	08/30/2000	John Underwood	730301-2016	1909

20999 7590 10/16/2007  
FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER
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CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2178

MAIL DATE	DELIVERY MODE
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10/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/651,875

**Applicant(s)**

UNDERWOOD ET AL.

**Examiner**

Joshua D. Campbell

**Art Unit**

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-15, 26-28, 35-39, 50-52, 54 and 56-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-15, 26-28, 35-39, 50-52, 54 and 56-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment filed 8/6/2007.

2. Claims 9-15, 26-28, 35-39, 50-52, 54, and 56-58 are pending in this case.

Claims 9, 26, 35, 50, 54, 56, and 57 are independent claims. Claims 9, 26, 35, 50, 54, 56, and 57 have been amended.

3. The rejection of claim 56 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter has been withdrawn due to amendments.

4. The rejection of claims 9-15, 26-28, 35-39, 50-52, 54, 56 and 57 under 35 U.S.C. 103(a) as being unpatentable over Dozier et al. (US Patent Number 6,393,469, filed on March 28, 1995) in view of Gentner (US Patent Number 5,724,595, filed on June 19, 1996) has been withdrawn due to amendments.

5. The rejection of claim 58 under 35 U.S.C. 103(a) as being unpatentable over Dozier et al. (US Patent Number 6,393,469, filed on March 28, 1995) in view of Gentner (US Patent Number 5,724,595, filed on June 19, 1996) as applied to claim 57 above, and further in view of Dutta (US Patent Number 6,775,208, filed on November 4, 1999) has been withdrawn due to amendments.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 9-15, 26-28, 35-39, 50-52, 54, and 56-58 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Currently all of the independent claims have amended limitations that pertain to defining one or more other pages of one or more other web sites which the user does not have authority to edit to include a link to the presented page. This type of limitation is then followed by a limitation that pertains to placing a link on at least one of the other pages of the one or more other web sites linking to the presented page. These two limitations as currently presented in the claims contradict each other thus providing a lack of enablement within the claims. It is completely unclear how a user would complete the latter of the two limitations discussed, i.e. placing the link, when the claim actually states in the earlier limitation that the user does not have the authority to accomplish this step. It is unclear if there is a remedy to this problem in the specification, at this point the examiner cannot locate any evidence of how the current claimed embodiment could accomplish the steps based on the specification. However, even if some possible explanation of how this embodiment would be carried out in the specification it would be necessary to move these steps into the claims because they would be considered to be essential steps for the claimed invention to properly work. The amendment made to the claims does not change the status of the rejection and does not have any impact on the limitations that are questioned by this rejection.

In order to further prosecution, the amendment of "...which the user does not have the authority to edit," will not be taken into account due to the fact that it renders the claims not functional and thus not enabled. Proper correction is required.

### ***Claim Objections***

8. The examiner would like to point out that the claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (See MPEP § 2111.04). The use of the phrase "for" in line 1 of claim 56 does not limit that claim due to the fact that the language suggests but does not require the stated functionality to actually be present, thus any statement in the claim that is preceded by the phrase "for" is not considered to provide any limitation to the claim.

9. Thus claim 56 is objected to because of the informalities stated above, which are viewed to be non-limiting due to the fact that they are preceded by the phrase "for".

In order to further prosecution the examiner will interpret the claims for the purpose of writing the rejection as though the statements that are objected to were actually limiting the claims (i.e. "A computer-readable medium having stored thereon ~~for storing~~ a set..."). However, this does not remove the claim objections stated above and proper correction is still required for claim 56 to overcome the objections as stated above.

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 9-15, 26-28, 35-39, 50-52, 54, and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dozier et al. (US Patent Number 6,393,469, filed on March 28, 1995) in view of Horstmann (US Patent Number 5,995,099, filed on June 10, 1996).

**Regarding independent claim 9,** Dozier et al. discloses a method in which a page of a web site (unit of multimedia information) is presented and a suggested list of pages, these pages all being currently accessed by the system and thus being valid (either local to the website, same WAN, or from another website, different WAN) that should be linked to that page are generated (column 4, lines 8-33 of Dozier et al.). Dozier et al. also discloses method of placing a hyperlink on a document residing on a WAN server without viewing it (column 4, lines 8-33 of Dozier et al.). Dozier et al. does not disclose that a link from the presented page being viewed should be placed on a target page or requesting that a request for referral should be made to the owner of the target page and a referral generated based on the request. However, Horstmann discloses a method in which a link may be created on a target page and a request be made for referral to the owner of that page, the referral being created in response to the owner's affirmation of the request (column 2, line 63-column 3, line 26 of Horstmann). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the method of automatically placing links and suggesting

pages to link to of Dozier et al. and the method of requesting referrals of Horstmann because it would have ensured reciprocity among websites using referrals (column 2, lines 1-4 of Horstmann).

**Regarding dependent claim 10**, Dozier et al. discloses a method in which once a list of pages that would be relevant to be linked to the presented document, the user is presented with a prompt, which is used to decide if links should be created between the two documents (column 14, lines 48-67 of Dozier et al.).

**Regarding dependent claims 11-13**, Dozier et al. discloses a method in which a page would be presented on a digital computer (multi-purpose input-output device) with multiple I/O peripherals that is connected to Wide area network, which would include a portable computer (laptop i.e. wireless device) (column 5, lines 35-45 of Dozier et al.).

**Regarding dependent claim 14**, Dozier et al. discloses a method in which a list of pages that would be relevant (based on language processing techniques) to be linked to the presented document is presented to the user (column 4, lines 9-18 of Dozier et al.).

**Regarding dependent claim 15**, Dozier et al. discloses a method in which pages that are relevant are grouped into categories that they share in common (i.e. author, language, etc.) (column 14, lines 48-67 of Dozier et al.).

**Regarding independent claim 26**, Dozier et al. discloses a method in which a page of a web site is presented and a suggested list of pages, these pages all being currently accessed by the system and thus being valid (either local to the website, same WAN, or from another website, different WAN) that should be linked to that page are

generated (column 4, lines 8-33 of Dozier et al.). Dozier et al. does not disclose that a link from the presented page should be placed on target pages. Dozier et al. does not disclose that a link from the presented page being viewed should be placed on a target page or requesting that a request for referral should be made to the owner of the target page and a referral generated based on the request. However, Horstmann discloses a method in which a link may be created on a target page and a request be made for referral to the owner of that page, the referral being created in response to the owner's affirmation of the request (column 2, line 63-column 3, line 26 of Horstmann). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the method of automatically placing links and suggesting pages to link to of Dozier et al. and the method of requesting referrals of Horstmann because it would have ensured reciprocity among websites using referrals (column 2, lines 1-4 of Horstmann).

**Regarding dependent claim 27,** Dozier et al. discloses a method in which the links in a collection of pages are modified if a navigation characteristic (changing the location or setting access controls) of a page is modified (column 4, lines 18-33 of Dozier et al.).

**Regarding dependent claim 28,** Dozier et al. discloses a method in which once a list of pages that would be relevant to be linked to the presented document, the user is presented with a prompt, which is used to decide if links should be created between the two documents (column 14, lines 48-67 of Dozier et al.).



**Regarding independent claim 35 and dependent claims 36-39**, the claims incorporate substantially similar subject matter as claims 9-15. Thus, the claims are rejected along the same rationale that is presented in the rejection of claims 9-15.

**Regarding independent claim 50 and dependent claims 51-52**, the claims incorporate substantially similar subject matter as claims 26-28. Thus, the claims are rejected along the same rationale that is presented in the rejection of claims 26-28.

**Regarding independent claims 54 and 56**, the claims incorporate substantially similar subject matter as claims 9. Thus, the claims are rejected along the same rationale that is presented in the rejection of claim 9.

**Regarding independent claim 57**, Dozier et al. discloses a method in which a page of a web site (referral page) is presented and a suggested list of information which correlates to other web publications topically related to the first page that the system believes should be linked to that page are generated, these publications all being currently accessed by the system and thus being valid (column 4, lines 8-33 and column 13, line 55-column 14, lines 67 of Dozier et al.). This topical list is based on the language found in the original page which can be based on author, topic, keyword, organizations (business names), and other data that could be compared between the first document and the list of second documents (Figures 8a-8b and column 13, line 55-column 14, lines 67 of Dozier et al.) Dozier et al. also discloses that the user may select one of the items from the list and create a referral (link) from the first website to the second website selected based on the correlated list item (column 4, lines 8-33 and column 13, line 55-column 14, lines 67 of Dozier et al. of Dozier et al.). Dozier et al.

does not disclose that a link from the presented page being viewed should be placed on a target page or requesting that a request for referral should be made to the owner of the target page and a referral generated based on the request. However, Horstmann discloses a method in which a link may be created on a target page and a request be made for referral to the owner of that page, the referral being created in response to the owner's affirmation of the request (column 2, line 63-column 3, line 26 of Horstmann). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the method of automatically placing links and suggesting pages to link to of Dozier et al. and the method of requesting referrals of Horstmann because it would have ensured reciprocity among websites using referrals (column 2, lines 1-4 of Horstmann).

**Regarding dependent claim 58,** Dozier et al. does not disclose presenting a request for referral to the owner of the target page and presenting the owner the option to automatically generate the referral. However, Horstmann discloses a method in which a link may be created on a target page and a request be made for referral to the owner of that page, the link for the referral being automatically created in response to the owner's affirmation of the request (column 2, line 63-column 3, line 26 of Horstmann). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the method of automatically placing links and suggesting pages to link to of Dozier et al. and the method of requesting referrals of Horstmann because it would have ensured reciprocity among websites using referrals (column 2, lines 1-4 of Horstmann).

***Response to Arguments***

12. Applicant's arguments filed 8/6/2007 regarding the 35 U.S.C. 112, first paragraph rejection have been fully considered but they are not persuasive. The applicant contends that the amendment made to the claims obviates this rejection, however this is not the case. Currently all of the independent claims have amended limitations that pertain to defining one or more other pages of one or more other web sites which the user does not have authority to edit to include a link to the presented page. This type of limitation is then followed by a limitation that pertains to placing a link on at least one of the other pages of the one or more other web sites linking to the presented page. These two limitations as currently presented in the claims contradict each other thus providing a lack of enablement within the claims. It is completely unclear how a user would complete the latter of the two limitations discussed, i.e. placing the link, when the claim actually states in the earlier limitation that the user does not have the authority to accomplish this step. Requesting for a referral from the owner of the target site after the link has already been placed (as shown in the amendments to the independent claims) does not overcome this rejection. It still remains unclear how a user would complete the latter of the two limitations discussed, i.e. placing the link, when the claim actually states in the earlier limitation that the user does not have the authority to accomplish this step. Page 63, lines 18-21 of the applicant's specification present the embodiment that the examiner believes the applicant is attempting to claim. In this section, no link is placed until after some form of permission is granted by the owner of the target site in the form of accepting the request for referral, thus a link is not placed until after the referral is

accepted and more importantly is not placed at all if the referral is not accepted. The current claim language contradicts the specification's showing of the applicant's process for generating links, and thus the claims remain rejected as lacking enablement. Proper correction is required and it is recommended that the applicant specify which portion of the specification supports future amendments to the claims.

13. Applicant's arguments with respect to the 35 U.S.C. 103(a) rejections of claims 9-15, 26-28, 35-39, 50-52, 54, and 56-58 have been considered but are moot in view of the new ground(s) of rejection.

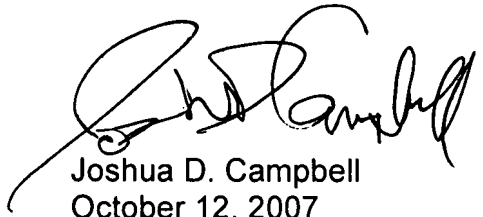
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Joshua D. Campbell  
October 12, 2007